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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/674,056
Filing Date: September 29, 2003
Appellant(s): HARIK, GEORGES R.

Leonard P. Linardakis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/2/09 appealing from the Office action mailed 5/19/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner: 35 USC 112, first paragraph, rejections of claims 72-74 and 76-78.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,876,997	Rorex et al.	4-2005
6,269,361	Davis et al.	7-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 67-70** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to **claims 67-70**, there does not appear to be support in the appellant's original specification for the limitation "*the predetermined number of the second plurality of search results is independent of a number of ads included on the generated search result page.*" The appellant has pointed to pages 10 and 11 as containing support for these claims, but no such support appears in those sections of the specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Appellant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 1-5, 29-33, and 57-78** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rorex et al.** (US 6,876,997, hereinafter "Rorex") **in view of Davis et al.** (US 6,269,361, hereinafter "Davis").

In regards to **claim 1**, **Rorex** teaches a method for generating information for an online advertisement, the method comprising:

a) generating a first plurality of search results using a search query and an index of advertiser Web page information **(Rorex; col. 4, lines 33-46, 52-58; col. 5, lines 16-31 – "pay for placement database … contains an ordered collection of search listing records used to generate search results in response to user queries." – the ordered collection of search listing records used to generate the search results is interpreted to be an index of advertiser web page information)**;

b) determining, for each of the first plurality of search results, at least one of (A) landing page information **(Rorex; col. 4, lines 33-46 – "generates a list of HyperText links to documents that contain information relevant to search terms entered by the user" – the document to which the link directs the user is interpreted to be a landing page, and the landing page information, i.e. the link and the associated document/landing page, are determined using the results of the user's search terms)** and (B) ad creative information using a corresponding one of the first plurality of search results;

c) generating, for each of the first plurality of search results, an ad using the determined at least one of a landing page information and ad creative information **(Rorex; col. 4, lines 33-46, 52-58; col. 5, lines 16-31, 52-57 – the paid search result listings are ads that are used to advertise a particular advertiser's product to the user, which is why an advertiser pays for placement of their web page in the search result listings, because it serves as an advertisement to attract users to a particular advertiser's product)**; and

d) generating a search result page including

i) at least a second plurality of search results corresponding to the search query **(Rorex; col. 5, lines 58-65; col. 7, lines 35-38)**, and

ii) the generated ads **(Rorex; col. 4, lines 33-46, 52-58; col. 5, lines 16-31, 52-57 – "The searcher may click on HyperText links associated with each listing in that search result page to access the corresponding web pages. The HyperText links … include paid listings to advertiser web pages" – the paid listings to advertiser web pages constitute ads)**,

wherein the generated ads are maintained as distinct from the second plurality of search result on the search result page **(Rorex; Fig. 3a; col. 6, line 60 – col. 7, line 8; col. 5, lines 58-65; col. 7, lines 35-38; appellant's specification at p11, lines 18-20 states "*preferably, the search results are maintained as distinct from the ads, so as not to confuse the user between paid advertisements and presumably neutral search results*", and Rorex at col. 5, lines 58-65 states "*non-paid listings follow the paid advertiser listings on the search results page*", which clearly meets not only the claimed limitation, but also its stated purpose as per the appellant's specification; in Rorex, the examiner is interpreting the non-paid listings on the search result page to be the second plurality of search results, which are displayed following the paid listings, i.e. ads, on the search result page and are thereby kept distinct from them)**.

Rorex does not expressly teach the second plurality of search results being a predetermined number.

Davis teaches unpaid listings being displayed after the paid listings to fill in the remainder of the 40 available slots in a search results page when there are an insufficient number

of relevant paid listings **(Davis; col. 18, lines 26-36)**. Therefore, the number of available slots for the unpaid listings is predetermined, based on the determined number of relevant paid listings, prior to displaying the listings.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the appellant's invention to implement the method of Rorex by including the teaching of Davis, whereby the number of unpaid listings is predetermined in an attempt to ensure that the searcher receives the most complete and relevant search results **(Davis; col. 5, lines 48-50)**.

Claims 2-4 are rejected based on their dependency on claim 1. Claim 1 recites, "determining at least one of landing page information and ad creative information," and the reference teaches determining landing page information, whereas claims 2-4 seek to further limit the determination of ad creative information.

In regards to **claim 5**, **Rorex and Davis** teach the method of claim 1 wherein the landing page information is a URL included in the search result **(Rorex; col. 5, lines 38-45)**.

In regards to **claim 58**, **Rorex and Davis** teach the method of claim 1 wherein the first plurality of search results and the second plurality of search results are generated by the same search operations **(Rorex; col. 7, lines 42-43 – same search terms/operators)**.

In regards to **claim 59**, **Rorex and Davis** teach the method of claim 1 wherein the ads included on the generated search results page are ordered using a search score **(Rorex; col. 7, lines 12-34)**.

In regards to **claim 60**, **Rorex and Davis** teach the method of claim 59 wherein the search score is a function of an information retrieval score **(Rorex; col. 7, lines 12-34)**.

In regards to **claim 57**, **Rorex and Davis** teach the method of claim 1, wherein the predetermined number of the second plurality of search results is no less than a number of ads included on the generated search results page **(Davis; col. 18, lines 26-36 - the number of unpaid listings could obviously be equal to or greater than the number of relevant paid listings for any given search in an attempt to ensure that the searcher receives the most complete and relevant search results)**.

In regards to **claim 61**, **Rorex and Davis** teach the method of claim 59.

Rorex and Davis do not expressly teach the search score being a function of a link analysis that assigns a numerical weighting to each element of a hyperlinked set of documents.

However, it would have been obvious to one of ordinary skill in the art at the time of the appellant's invention to use PageRank to determine the search score in Rorex and Davis, since PageRank is a popular and well-known ranking methodology.

In regards to **claim 67**, **Rorex and Davis** teach the method of claim 1.

Rorex and Davis do not expressly teach the predetermined number of the second plurality of search results being independent of a number of ads included on the generated search result page.

However, it would have been obvious to one of ordinary skill in the art at the time of the appellant's invention that rather than filling the remaining available slots of Rorex and Davis with the unpaid listings, a fixed amount of the available slots could be reserved for unpaid listings, in order to provide the user with the most relevant listings.

In regards to **claim 68**, **Rorex and Davis** teach the method of claim 1 wherein the predetermined number of the second plurality of search results is more than a number of the ads included on the generated search result page **(Davis; col. 18, lines 26-36 - the number of unpaid listings could obviously be greater than the number of relevant paid listings for any given search in an attempt to ensure that the searcher receives the most complete and relevant search results)**.

In regards to **claim 71**, **Rorex and Davis** teach the method of claim 1 wherein ad creative information is determined, for each of the first plurality of search results, and wherein the determined ad creative information is used to generate the ad for each of the first plurality of search results **(Rorex; col. 4, lines 52-61; Figs. 3A and 3B)**.

In regards to **claim 72**, **Rorex and Davis** teach the method of claim 71 wherein the ad creative information is determined using information automatically extracted from an advertiser

Web page **(Rorex; col. 4, lines 59-61; col. 5, lines 35-51 – URL and bid amount, for example)**.

In regards to **claim 73**, **Rorex and Davis** teach the method of claim 71 wherein the ad creative information is determined using a text snippet of the corresponding search result **(Rorex; col. 4, lines 59-61; Figs. 3A and 3B)**.

In regards to **claim 74**, **Rorex and Davis** teach the method of claim 71 wherein the ad creative information includes information automatically extracted from an advertiser Web page **(Rorex; col. 4, lines 59-61; col. 5, lines 35-51)**.

Claims 29-33, 62-66, 69-70, and 75-78 are rejected with the same rationale given for claims 1-5, 57-61, 67-68, and 71-74, respectively.

(10) Response to Argument

Rejections under 35 USC 112

With respect to the 35 USC 112, 1st rejections, appellant's argument that the specification does not say that the number of search results depends on the number of ads shown is not evidence of support for the limitation that the number of search results is *independent* of the number of ads. In fact, this appears to be equivalent to a negative limitation used in an attempt to overcome the prior art. Regarding negative limitations, MPEP 2173.05(i) states in part, "Any negative limitation or exclusionary proviso must have basis in the original disclosure," and "Any

claim containing a negative limitation, which does not have basis in the original disclosure, should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement." Again, this limitation appears to have been included in an attempt to overcome the references relied upon without adequate support in the appellant's own specification.

Rejections under 35 USC 103

Group I: Claims 1-5, 29-33, 58, 59, 61, 63, 64, 66-71, 73-75, 77 and 78

Appellant argues that the references do not teach that the generated ads are maintained as distinct from the second plurality of search results on the search result page.

The examiner respectfully disagrees. The examiner asserts that Rorex at col. 5, lines 58-65 states "*non-paid listings follow the paid advertiser listings on the search results page*". The examiner is interpreting the non-paid listings on the search result page to be the second plurality of search results, which are displayed following the paid listings, i.e. ads, on the search result page and are thereby kept distinct from them, meeting the language of the claim as written.

Appellant also argues that the references do not teach that the second plurality of search results, i.e. the unpaid listings in the Davis reference, is a predetermined number.

The examiner respectfully disagrees and asserts that "predetermined" is a broad term and that it is not clear based on the language of the claim what the number of search results in the second plurality of search results must be determined before in order to be considered predetermined. Davis teaches that the number of available slots for the unpaid listings are predetermined with respect to displaying the listings. Predetermined is a broad term and Davis

teaches determining the number prior to displaying, which constitutes a predetermined number. In other words, in Davis, the number of search results in the second plurality of search results is *determined before displaying* those search results, and are therefore *predetermined* with respect to display.

Group II: Claims 57 and 62

Appellant argues that neither Rorex nor Davis teach that the predetermined number of unpaid listings is no less than a number of ads included on the generated search results page. The examiner respectfully disagrees with the appellant's argument and asserts that given the teachings of Rorex and Davis, it is obvious that the number of unpaid listings could be greater than a number of ads included on the search result page, which satisfies the claimed limitation of "no less than."

Group III: Claims 60 and 66

Appellant argues that the ordering of ads in Rorex is solely dependent on the bid amount and does not take into account an information retrieval score.

The examiner respectfully disagrees and asserts that Rorex states that "*Preferably, the rank value 360a-360i is assigned in a process, implemented in software, that establishes an association between the bid amount, the rank, and the search term of a search listing,*" (Rorex; col. 7, lines 17-20) and clearly teaches using information retrieval scores in ordering search results, as depicted by Fig. 5 of Rorex. Furthermore, the examiner asserts that the term "information retrieval score" is not defined in the appellant's specification in a manner that

would preclude interpreting a ranking of search results based on relevancy and bidding from being considered an ordering based at least in part on information retrieval scores.

Group IV: Claims 72 and 76

Appellant argues that Rorex and Davis do not teach that ad creative information is determined using information automatically extracted from an advertiser Web page.

The examiner respectfully disagrees and asserts that Rorex teaches that the ad creative information is indeed determined using information automatically extracted from an advertiser Web page in that the ad creative information includes at least a URL, a title, and a bid amount for an associated advertiser Web page (Rorex; col. 4, lines 59-61; col. 5, lines 35-51). The URL is clearly extracted from the associated Web page, as is the title and descriptive text (Rorex; Figs. 3A and 3B).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/K. P./

Examiner, Art Unit 2161

June 4, 2009

Conferees:

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